

REMARKS/ARGUMENTS

Claims 1, 2 and 15 are pending in the instant application. Claims 3 through 14 and 16 through 18 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species. Claim 1 has been amended, support for which may be found at page 8, lines 21 through 26, and elsewhere within applicant's specification, as originally filed.

The Examiner has indicated that the substitute drawings received on June 4, 2004 are acceptable. The Examiner has objected to the abstract of the disclosure under MPEP § 608.01(b). The Examiner has rejected claims 1, 2 and 15 under 35 U.S.C. 103(a) as being unpatentable over Yoon et al., U.S. Patent No. 4,981,149, in view of Hubbard et al., U.S. Patent No. 3,308,820. The objection to applicant's abstract of the disclosure and the rejection of applicant's claims are respectfully traversed. Reconsideration and favorable action is respectfully solicited in view of the following.

The Examiner has objected to the abstract of the disclosure under MPEP § 608.01(b). The Examiner has stated that:

The abstract of the disclosure is objected to because the abstract should avoid the word "invention." Correction is required.

In response thereto, the applicant has amended the abstract of the disclosure to address the issue raised by the Examiner. In view thereof, it is respectfully requested that the grounds for objection to the abstract of the disclosure be removed.

Application No.: 10/674,332
Dated: April 2, 2007
Amendment

The Examiner has rejected claims 1, 2 and 15 under 35 U.S.C. 103(a) as being unpatentable over Yoon et al., U.S. Patent No. 4,981,149, in view of Hubbard et al., U.S. Patent No. 3,308,820. The Examiner is of the view that:

Yoon teaches a hollow suturing needle (60) comprising an internal cavity wherein a drug to be dispensed can be released by holes extending through walls communicating with the lumen and sealed in the suture needle by attachment of suture material which does not extend the length of the lumen, and wherein the fluid may be an antibiotic (Column 7, proximate lines 4-20).

Yoon fails to teach a compressed gas residing between the fluid and the non-hollow portion or seal. Hubbard teaches a device having an internal cavity therein comprising: a proximal end (18), a distal end (16), a point on the distal end (fig. 2), an opening at or in the proximity of the distal end, and a non-hollow portion or seal at or adjacent to the proximal end (16); wherein the internal cavity is in fluid communication with said opening at one end and terminates at said non-hollow portion or seal at the other end (fig. 1); a fluid (M) residing within the internal cavity; and a compressed gas (G) residing between the fluid (M) and the non-hollow portion or seal (18), (Columns 3-4, proximate lines 60-75 and 1-5 respectively), in order to provide a disposable fluid dispensing device that is simple to manufacture and provides effective ejection of medicine from the device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Yoon with the pressurized gas ejection mechanism of Hubbard in order to provide a disposable needle that is simple to manufacture and provides effective ejection of medicine from the device.

Yoon et al., U.S. Patent No. 4,981,149, proposes bioabsorbable suture devices for use in endoscopic surgery. The proposed devices include a suture needle made of bioabsorbable material for pulling a length of suture material through bodily tissue, allowing the suture needle to be inadvertently or intentionally left in the tissue, and a suture needle having a length of suture material attached thereto with a contractible loop or passage at the proximal end of the suture material to allow the suture needle to be passed therethrough, the loop or passage contracting to clamp or grip the suture material to function similar to a conventional tied suture knot.

As may be appreciated, a careful review of the Yoon et al. reference reveals that nowhere is a suture needle having an internal cavity therein that includes a proximal end, a distal end, a point on the distal end, an opening at or in the proximity of the distal end, and a non-hollow portion or seal at or adjacent to the proximal end; the internal cavity in fluid communication with said opening at one end and terminates at said non-hollow portion or seal at the other end, a fluid residing within the internal cavity and a compressed gas residing between the fluid and the non-hollow portion or seal, wherein the suture needle is produced from metal tubing, fairly taught or suggested. The Examiner relies upon Hubbard et al., U.S. Patent No. 3,308,820, to remedy these deficiencies.

Hubbard et al., U.S. Patent No. 3,308,820, proposes a disposable medicinal hypodermic syringe that is said to have utility in the administration of a liquid medicament. The disposable medicinal hypodermic syringe is a single unitary structure having a sealed vial unit containing a charge of liquid medicine or other liquid to be injected into the patient's tissue under sealed gas pressure; a hollow injection needle or cannula; and a mechanically stabilized, transparent and flexibly compressible aspiration sleeve or tube unit sealingly applied between the vial unit and the cannula, for checking by vacuum inducement against the possibility that the cannula has penetrated a blood vessel, prior to the discharge of the medicine under gas pressure into muscular tissue. The syringe may also be used for intravenous injection.

It is respectfully submitted that to approach applicant's claimed invention would require that, at a minimum, the suture needle of Yoon et al., which is produced from a bioabsorbable material, be replaced with one produced from metal tubing, a modification that would destroy the stated object and function of the Yoon et al. invention. As stated at col. 3, lines 13-19 of Yoon et al.

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[It is a]n object of the present invention is to construct a suture needle ... of a bioabsorbable material such that, should the suture needle be dropped or lost during endoscopic surgery, open surgery is not required to remove the needle.

As is well-settled under the law, if a reference is cited that requires some modification in order to meet the terms of applicant's claimed invention and that modification would destroy the purpose or function of the invention disclosed in the relied-upon reference, one of ordinary skill in the art would find no reason to make the proposed modification. The Federal Circuit has consistently held that when a rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in that reference, such a proposed modification is not proper and a prima facie case of obviousness cannot be properly made. The Federal Circuit noted in In re Gordon, at 221 USPQ 1127, 733 F.2d 902, that "the mere fact that the reference could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." It is respectfully submitted that the lack of technical motivation for making the modifications necessary to arrive at applicant's claimed invention is evidence that the suggestion for the modification could not have come from the references themselves.

In view thereof, the applicant respectfully requests that the rejection of claims 1, 2 and 15 under 35 U.S.C. 103(a) as being unpatentable over Yoon et al., U.S. Patent No. 4,981,149, in view of Hubbard et al., U.S. Patent No. 3,308,820, be removed.

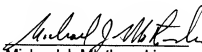
The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Account No. 50-2478(13925).

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It is respectfully submitted that the present claims are in condition for allowance. Prompt notification of allowance is respectfully solicited.

Respectfully submitted,

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